

REMARKS

Reconsideration and further examination of this application is respectfully requested. Independent claims 1, 5, 6, 9 and 10 have been amended to include processes for repairing the copy of the image file if the verification processes determine that the copy of the image file is not a functional duplicate of the image file and to repair errors in the labeling process if the master/production graphical label is not a functional duplicate of the graphical representation material in the image file. Support for the amendments to independent claims 1, 5, 6, 9 and 10 may be found in the original subject patent application in Figures 1A & 1B and the description in the specification with respect to Figures 1A & 1B. Independent claims 1, 5, 6 and 9 have also been amended to include a process for labeling the production compact disc as disclosed in original independent claim 10 of the subject patent application. Dependent claims 15-19 have been added to include the feature of performing an MD5 data check to verify the copy of the image file in the verification processes of the parent independent claims. Support for the MD5 data check feature may be found throughout the original specification of the subject patent application, and may specifically be found on page 7 at lines 5-7 of the original subject patent application. Dependent claims 2-4, 7-8 and 11-14 appear in their original form. There were originally 5 independent claims and there remain 5 independent claims after the claim amendments and additions. After adding new dependent claims, there are a total of 19 claims. Thus, as no independent claims were added and the total claims after adding new dependent claims is under 20 total claims, no additional fee is required for the addition of the new claims. Therefore, Applicants submit claims 1-19 for further examination. Applicants have included the petition and payment for a one-month extension fee with the submittal of this Amendment A.

No new matter has been added by the above described claim amendments and new claims.

In the subject Office Action, the Examiner rejected claims 1, 2, 4, 6, 7, 10, 11, 13 and 14 under 35 U.S.C. 102(b) as being anticipated by Admitted Prior Art. The Examiner rejected claims 3, 5, 8, 9 and 12 under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art.

Without specifically stating such, it appears that the Examiner has assumed that any text in the *Background of the Invention* section of the subject patent application is considered prior art admitted by Applicants (i.e., Admitted Prior Art). The Examiner did not state the applicable case law, statutory, and/or regulatory support for the assumption that any text in the *Background*

of the Invention section is to be considered prior art. 35 U.S.C. 102(b) states: “A person shall be entitled to a patent unless – . . . the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.” *Emphasis added*. Clearly, the *Background of the Invention* section of the subject patent application was not published more than one year prior to the filing date of the same subject patent application and/or does not constitute an application for patent applied for more than one year prior to the filing date of the same subject patent application. As such, the Examiner has made an improper rejection under 35 U.S.C. 102(b) since the subject patent application clearly does not fall within the description of prior art under 35 U.S.C. 102(b).

Applicants are unable to locate in the case law, statutes, and/or rules an assertion that any text in the *Background of the Invention* section is to be considered prior art. As best understood by Applicants, the case law states that “anything admitted to be ‘prior art’ in those very words (‘ipissimis verbis’) would be considered prior art.” Donald S. Chisum, *Chisum on Patents*, §5.03(3)(e)(i), Matthew Bender & Company, Inc., 1975, *discussing In re Nomiya*, 509 F.2d 566, 184 USPQ 607 (CCPA 1975). Applicants have not stated that the paragraph of the subject patent application (i.e., the paragraph starting on page 1, line 17 and ending on page 2, line 2) is prior art. Applicants respectfully submit that it was the intention of Applicants to include the subject paragraph to describe the invention of the subject patent application in contrast to the problems of damage and/or corruption of software files and media storage devices also described in the *Background of the Invention* section of the subject patent application. To avoid confusion, Applicants have amended the specification of the subject patent application to remove the paragraph starting on page 1, line 17 and ending at page 2, line 2, and place the removed paragraph in the *Detailed Description of the Invention* section of the subject patent application on page 6 at line 15. If the Examiner intends to maintain that the cited portion of the subject patent application is “Admitted Prior Art,” Applicants respectfully request that the Examiner please cite the applicable case law, statute, or rule that supports the assertion.

No new matter has been added by the above described amendments to the specification.

As described above, the portion of the subject patent application asserted by the Examiner to be “Admitted Prior Art” is improper under 35 U.S.C. 102(b). Further, Applicants have not specifically stated that the portion of the subject patent application cited by the

Examiner is “prior art.” Thus, the cited portion of the subject patent application does not qualify as prior art according to the holding of *In re Nomiya*. Thus, the cited portion of the subject patent application is not a proper prior art reference under 35 U.S.C. 102 and/or 35 U.S.C. 103, and the Examiner has not made a proper *prima facie* rejection under 35 U.S.C. 102 and/or 35 U.S.C. 103. The Examiner did not cite any prior art other than the improper reference to the portion of the original subject patent application. Therefore, claims 1-19 of the subject patent application are considered to be patentable under 35 U.S.C. 102(b) and/or 35 U.S.C. 103(a) since the Examiner has not cited any proper and applicable prior art.

Assuming, *arguendo*, that the portion of the subject patent application cited by the Examiner as “Admitted Prior Art” qualifies as prior art, the rejection under 35 U.S.C. 102(b) still fails to anticipate all features of the claims of the subject patent application. In the subject Office Action, the Examiner asserted that page 1, lines 20-22 and page 1, line 31 to page 2, line 1 of the original subject patent application disclose the features of claim 1 that recite:

“copying said image file from said memory device to a compact disc-making machine;
 copying said image file from said compact disc-making machine to a blank compact disc
 to produce a production compact disc; . . .
verifying that said surface of said production compact disc displays a functional duplicate
 of said graphical representation material contained in said image file; . . . [and]
verifying that said production compact disc contains a functional duplicate of said image
 file from said compact disc-making machine.” *Emphasis added.* Claim 1 presented as
 amended herein since the applicable sections have not been altered substantially.

Page 1, lines 20-22 of the original subject patent application states: “These software and data files typically undergo separate testing procedures anytime the files are moved, integrated or transferred to a different media to ensure their accuracy and proper function.” Page 1, line 31 to page 2, line 1 of the original subject patent application states: “Future reproductions of the CD are generated from the electronic job files and not from other hardware such as tapes or ‘master’ CDs.” Applicants are unable to find a disclosure of the use of a compact disc-making machine in the portions of the original patent application cited by the Examiner. Applicants are also unable to locate a disclosure of a compact disc-making machine in the remaining portions of the original *Background of the Invention* section of the subject patent application. Further, Applicants are unable to find a disclosure, teaching or suggestion of the verification of the copy of the image file contained on the production compact disc and the graphical representation material displayed

on the surface of the production compact disc as recited in claim 1 of the subject patent application. Applicants are further unable to locate a disclosure, teaching or suggestion of verifying the copy of the image file on the production compact disc and the graphical representation material on the surface of the production compact disc in the remaining portions of the original *Background of the Invention* section of the subject patent application. Therefore, claim 1 of the subject patent application is not anticipated under 35 U.S.C. 102(b) by the portion of the original subject patent application asserted by the Examiner to be “Admitted Prior Art.”

As amended, claim 1 of the subject patent application also recites:”

“repairing said image file if said image file does not contain said functional duplicate of said master files; . . .

isolating and repairing files in said image file copy stored on said memory device if said memory device does not contain a functional duplicate of said image file; . . .

isolating and repairing files in said image file copy on said master compact disc if said master compact disc does not contain a functional duplicate of said image file; . . .

isolating and repairing errors in production of said graphical representation on said surface of said master compact disc if said surface of said master compact disc does not contain a functional duplicate of said graphical representation stored in said image file; . . .

isolating and repairing files in said image file copy on said production compact disc if said production compact disc does not contain a functional duplicate of said image file; . . .

isolating and repairing errors in production of said graphical representation on said surface of said production compact disc if said surface of said production compact disc does not contain a functional duplicate of said graphical representation stored in said image file.”

Emphasis added.

Claim 1, as amended, clearly recites processes for repairing files in the copy of the image file at various stages of the compact disc production process as well as repairing errors in the process for graphically labeling a surface of both the master and production compact discs. Applicants are unable to locate a disclosure, teaching or suggestion of repairing files in the copy of the image file and/or repairing errors in the process for graphically labeling a surface of the master/production compact discs in the portion of the original subject patent application asserted to be “Admitted Prior Art” by the Examiner and/or in the remainder of the *Background of the Invention* section of the original subject patent application. Therefore, for the additional processes for repairing the image files and labeling process, claim 1 of the subject patent

application is not anticipated under 35 U.S.C. 102(b) by the portion of the original subject patent application asserted by the Examiner to be “Admitted Prior Art.”

It is axiomatic that the standard for lack of novelty under 35 U.S.C. 102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all of the claim’s essential elements. As described above, Applicants are unable to locate a disclosure of a compact disc-making machine, verifying the copy of the image file on the production compact disc and the graphical representation material on the surface of the production compact disc, and/or repairing files in the copy of the image file and/or repairing errors in the process for graphically labeling a surface of the master/production compact discs in the section of the original subject patent application asserted to be “Admitted Prior Art” by the Examiner in the subject Office Action. Thus, the portion of the original subject patent application asserted to be “Admitted Prior Art” by the Examiner does not teach, disclose, or suggest the features of a compact disc-making machine, verifying the copy of the image file on the production compact disc and the graphical representation material on the surface of the production compact disc, and/or repairing files in the copy of the image file and/or repairing errors in the process for graphically labeling a surface of the master/production compact discs as described above and as recited in as amended claim 1 of the subject patent application. Therefore, the portion of the original subject patent application asserted to be “Admitted Prior Art” by the Examiner does not anticipate claim 1 of the subject patent application under 35 U.S.C. 102(b). Since the portions of the original subject patent application asserted to be “Admitted Prior Art” by the Examiner do not disclose, teach or suggest the features recited by as amended claim 1 of the subject patent application, claim 1 is also not obvious in view of the portion of the original subject patent application asserted to be “Admitted Prior Art” by the Examiner and is therefore patentable over the portion of the original subject patent application asserted to be “Admitted Prior Art” by the Examiner under 35 U.S.C. 103(a).

Independent claims 5, 6, 9 and 10 have similar features as independent claim 1 and are patentable over the portion of the original subject patent application asserted to be “Admitted Prior Art” by the Examiner under 35 U.S.C. 102 and 103 for the same reasons as for claim 1. Dependent claims 2-4, 7-8 and 11-19 depend from independent claims 1, 5, 6, 9 and/or 10 and are also patentable over the portion of the original subject patent application asserted to be

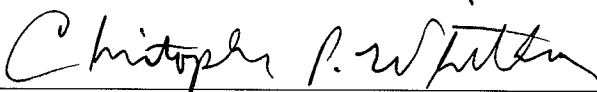
“Admitted Prior Art” by the Examiner under 35 U.S.C. 102 and 103 since they depend from a valid independent claim.

Further, Applicants are unable to locate a disclosure, teaching or suggestion of the MD5 data check in the portion of the original subject patent application asserted to be “Admitted Prior Art” and/or the remainder of the original Background of the Invention section of the subject patent application. Dependent claims 15-19 recite the feature of using the MD5 data check to verify copies of the image file. Therefore, dependent claims 15-19 are also patentable over the portion of the original subject patent application asserted to be “Admitted Prior Art” by the Examiner under 35 U.S.C. 102 and 35 U.S.C. 103 for additional feature of the use of the MD5 data check.

For the reasons stated above, claims 1-19 are considered to be patentable. Therefore, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Dated this 14th day of July, 2008.

COCHRAN FREUND & YOUNG LLC

By: 
Christopher P. Whitham #53,769
Attorney for Applicants
2026 Caribou Drive, Suite 201
Fort Collins, CO 80525
(970) 492-1100
Fax: (970) 492-1101